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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,647	03/17/2004	Christophe Szabo	003301-128	1690

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EXAMINER

MAI, NGOCLAN THI

ART UNIT PAPER NUMBER

1742

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/801,647

Applicant(s)

SZABO ET AL.

Examiner

Ngoclan T. Mai

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 and 19-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 13-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/17/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of the Group I invention, claims 1 to 7 and 13 to 18 in the reply filed on 5/18/05 is acknowledged. The traversal is on the ground(s) that the fields of search for the Group I and Group II inventions appear to be co-extensive. This is not found persuasive because of the followings:

With regard to applicants' allegation that the fields of search for the Group I and Group II inventions are co-extensive. This is found unconvincing because the issues of product and method claims are divergent. There may be some overlap in the searches of the two groups, but there is no reason to believe that the searches would be identical. Furthermore, the examination of the process claims is based on a different criteria from that of the device claims, hence the examination of the two groups is not co-extensive. Therefore, based on the additional work involved in searching and examination of the two distinct inventions together that would present serious burden to the examiner, restriction of distinct invention is clearly proper.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 8 to 12 and 19 to 22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on May 18, 2005.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al. (US 4,089,682).

Saito discloses a reduced powder having sponge-like structure comprising a group of the primary powder of irregular shapes. The reduced powder is comprises of 15-35% chromium, 0.2 to 3.5% carbon and the balance Co. (col. 3, line 24 to col. 4, line12). Since Saito teaches the reduced powder with constituent whose wt% range overlaps that recited by the claim; such overlapping range renders applicant's composition prima facie obvious despite difference in non-overlapping areas, see In re Malagari, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

5. Claim 1-7, and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitaker et al. (2004/0237712) in view of Kumar et al (US 4,464,206).

Whitaker discloses a cobalt based pre-alloy comprising Cr 5-30%, Mo 0-15%, Ni 0-25%, W 0-15%, C 0-5%, Si 0-5%, B 0-5%, Fe 0-5%, Mn 0-5%, total others 10% max and Co balance, paragraph [0010] and [0015]. The pre-alloy powder is taught to be

irregular in shape in order to achieve sufficient green strength for the articles to be handleable and survive die ejection, paragraph [0024].

The difference between the claims and Whitaker is that Whitaker does not specifically teach the presence of graphite in the powder metal composition.

Kumar teaches carbon is normally added to pre-alloy powder of cobalt-base alloy to adjust the chemical composition of the product, Kumar, col. 1, lines 60-68.

Thus it would have been obvious to one of ordinary skill in the art to admix the cobalt-based pre-alloy powder taught by Whitaker with graphite to adjust the chemical composition of the final product to obtain desired result.

As for the amounts of graphite added to the powder composition as recited in claims 6 and 18, since the desired amount of carbon is taught by Whitaker, it would have been obvious to one ordinary skill in the art at the time the invention was made to determine the amount of graphite added to the cobalt-based pre-alloy powder of Whitaker, if the desired level of carbon in the pre-alloy powder is not sufficient, to adjust the chemical composition as taught by Kumar in order to obtain final product with the desired carbon amount as taught by Whitaker. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable range by routine experimentation.” See *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955); *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969); *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d (Fed.cir), cert. denied, 493 U.S. 975 (1989); *In re Kulling*, 897 F.2d 1147, 14 USPQ2d 1056 (Fed. Cir. 1990); and *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997).


Regarding the limitations of C amounts in claims 1, 4, and 15-17, since Whitaker discloses the claimed cobalt-based pre-alloy having carbon whose wt% range overlaps that recites by the claims, it would have been obvious to one of ordinary skill in the art to select any portion of range, including the claimed range, from the broader range disclosed Whitaker because Whitetaker finds that carbon in the entire disclosed range has a suitable utility. --- Note: Even if a reference teaches a preferred range within a broader range, it still does not "teach away" from the claimed invention. See MPEP 2123.

As for the limitation of claim 7, Whitaker discloses adding Sn as processing aid and solid lubricant material, see abstract.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoclan T. Mai whose telephone number is (571) 272-1246. The examiner can normally be reached on 9:30-6:00 PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ngoclan T. Mai
Primary Examiner
Art Unit 1742

n.m.